

REMARKS

Claims 1-13 are pending in the application. Claim 7 has been amended and claim 14 has been added, leaving claims 1-14 for consideration upon entry of the present amendment. Applicants request reconsideration in view of the Amendment and Remarks submitted herewith.

Claims 1-3, 5, 7-11, and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hyde, Jr. (US 6,038,553) ("Hyde"). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the * * * claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1-3, and 5 include the following limitation: "feeding a bank note to a digitalization station via a transport unit, at least partially digitizing the bank note to create digitized data and comparing the digitized data with a stored data in a computer unit." Hyde does not teach or suggest this limitation.

Hyde teaches comparing digitized data of the check (OCR) with data (date and amount of the check) entered by the customer himself. See column 8, lines 31-36. As such, the data entered is by the customer himself, and is not "a stored data." In addition, Hyde does not teach or suggest digitizing data of a bank note or storing the digitized data of the bank note in a computer unit. Thus, Hyde does not disclose any data, which can be compared to the digitized data of the bank note for performing a test of acceptability. Data that has been entered by a customer is not suitable for performing a test of acceptability of a bank note. Accordingly, Hyde does not anticipate claims 1-3 and 5.

Claims 7-11 and 13, as amended, include the following limitation: "wherein at least the unit for receiving a bank note and the image display unit are disposed in one location." Support for the amendment is found at page 4, last paragraph, page 6, the fifth full paragraph. While the unit for receiving the bank note and the image display unit do not necessarily need to be located in one housing, the claim requires that all of the unit for receiving a bank note and the image display unit are disposed in one location. This allows the operator to feed the bank note into the unit for receiving a bank note and to determine whether the bank note is acceptable.

In contrast, Hyde teaches that the teller module 23 and the transaction module 27 are different physical pieces of equipment, which are located in different locations. The teller

module 23 is a remote image display unit. Hyde does not teach or suggest that the image display unit 27 must be located at the same place unit for receiving a bank note 53. In fact, Hyde teaches that the image display unit 27 must be located remotely from the unit 53. See Figure 1. Accordingly, Hyde does not anticipate claims 7-11 and 13.

Claims 4, 6, and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hyde. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). In this case, the references do not teach or suggest all of the limitations.

Claims 4 and 6 include all of the limitations of claim 1 and claim 12 includes all of the limitations of claim 7. As explained above, Hyde does not teach or suggest all of the limitations of either claim 1 or claim 7. Accordingly, Applicants respectfully request that the rejection as to claims 4, 6, and 12 under 35 U.S.C. § 103(a) be withdrawn.

Claim 14 has been added and it depends from claim 7. Thus, because claim 14 includes all of the limitations of claim 7, claim 13 is also allowable. Applicants respectfully request that claim 14 be allowed.

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

Respectfully submitted,

CANTOR COLBURN LLP

By:

Lisa Bongiovi
Lisa A. Bongiovi
Registration No. 48,933
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No. 23413

FAX RECEIVED

MAY 27 2003

TECHNOLOGY CENTER 2800

May 27, 2003